

## REMARKS

### Claim Amendments

The preamble of claim 1 has been amended to correct a typographical error in the spelling of “steps”.

Claims 3, 5, 22, and 24 have been amended to correct a typographical error in the spelling of “fumaric” acid.

Claim 1 has been amended to recite the limitation, “wherein the emulsion comprises polymer particles of average discrete phase particle size of less than about 10 microns”. This limitation is supported, at least, by the paragraph bridging pages 7 and 8 of the application as filed.

Claim 26 has been amended to recite, in part, “A composition comprising an oil-based mud with a water-in-oil emulsion comprising a continuous oil phase and a discontinuous aqueous phase which is in the form of droplets or particles containing a polymer derived from at least one water-soluble monomer”. Support for this portion of the claim may be found in claim 26 and the first paragraph on page 7 of the application as filed.

Claim 26 has also been amended to recite the limitation, “wherein the discontinuous aqueous phase comprises polymer particles of average discrete phase particle size of less than about 10 microns”. This limitation is supported, at least, by the paragraph bridging pages 7 and 8 of the application as filed.

### Nonstatutory Double Patenting Rejections

Claims 26-28 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 19 and 21 of co-pending U.S. Patent Application Serial No. 10/892,847. 12/7/2006 Office Action, page 2, first paragraph.

Claim 3 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Patent Application Serial No. 10/892,847 in view of claim 19 of the same application. 12/7/2006 Office Action, page 2, second paragraph.

Applicants thank the Examiner for pointing out the potential obviousness-type double patenting issues between the claims of the present application and those of co-pending application No. 10/892,847. In view of the current amendments to the present claims and the possibility that claims in the cited application will be further amended before allowance, Applicants will defer responding to this provisional rejection until claims in the present application are otherwise allowable on the merits. As stated in previous responses, Applicants plan to file an appropriate terminal disclaimer at such time as the present application is considered otherwise allowable on the merits. The rejections will be overcome by the filing of the terminal disclaimer.

#### Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. 12/7/2006 Office Action, page 3, second paragraph. In particular, the Examiner has stated, “In each of claims 1 and 26 the added limitation ‘wherein the average discrete phase particle size...’ lacks clear antecedent basis, see the section of the Office Action labeled ‘Allowable Subject Matter’ for recommendation on resolving this problem.” 12/7/2006 Office Action, page 3, third paragraph.

Claims 1 and 26 have been currently amended to restate the particle size limitation as follows: “wherein the emulsion comprises polymer particles of average discrete phase particle size of less than about 10 microns”. This amendment is consistent with the Examiner’s suggested amendment to claim 1 as discussed in the 12/7/2006 Office Action in the last paragraph on page 4. Because the amendment avoids any reference to “the average discrete phase particle size”, it renders moot the rejection based on lack of antecedent basis. Accordingly, Applicants respectfully request the

reconsideration and withdrawal of the rejection of claims 1-28 under 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 26-28 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 4,777,200 to Dymond et al. (“Dymond”). 12/7/2006 Office Action, page 3, next-to-last paragraph. Applicants respectfully traverse this rejection to the extent it may be applicable to the claims as amended.

Applicants respectfully suggest that independent claim 26 is not anticipated by Dymond because Dymond does not teach the claim 26 limitation, “wherein the discontinuous aqueous phase comprises polymer particles of average discrete phase particle size of less than about 10 microns”. Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). On the issue of the particle size limitation of claim 26, it is important to keep in mind that Dymond describes two general classes of polymers. The first class of polymers is a “water-soluble or water-swellaable polymer”. See, e.g., Dymond abstract, first two lines. The second class of polymers, which is the focus of Dymond’s invention, is the “water insoluble viscosifying polymer”. See, e.g., Dymond abstract, lines 3-4. Dymond’s size limitation of “a dry size below 10  $\mu\text{m}$ ” applies to the water insoluble viscosifying polymer, not to the water-soluble or water-swellaable polymer. Dymond abstract. Thus, Dymond does not teach Applicants’ claim 26 limitation, “wherein the discontinuous aqueous phase comprises polymer particles of average discrete phase particle size of less than about 10 microns”, and Dymond therefore does not anticipate claim 26. Given that claims 27 and 28 each depend directly from claim 26, they too are not anticipated by Dymond. Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 26-28 under 35 U.S.C. § 102(b) over Dymond.

Allowable Subject Matter

Applicants are grateful for the Examiner's acknowledgment of allowable subject matter. In particular, the Examiner has stated,

Pending resolution of double patenting rejection, independent claim 1 would distinguish if amended to recite "contacting . . . prior to contact with said oil-based mud ***[and]*** wherein the ***emulsion comprises polymer particles of*** average discrete phase particle size ***of [the polymer] less than about 10 microns...***" ***It is acknowledged that neither of the applied prior art references, Chen or Thompson, suggest such polymer particles applied to separate solids from liquid in an oil-based mud.***


12/7/2006 Office Action, page 4, last paragraph (emphasis in original). As discussed above, Claim 1 has been amended as suggested by the Examiner.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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